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FIFTY-SIX HOPE ROAD MUSIC, LTD.
and ZION ROOTSWEAR, LLC

UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA

Fifty-Six Hope Road Music, Ltd., a
Bahamian corporation; Zion
Rootsweat, LLC, a Florida limited
liability company; and The Robert
Marley Foundation, Ltd., a Jamaican
corporation,

Plaintiffs and
Counter-Defendants,

vs.

A.V.E.L.A., Inc., a Nevada corporation;
X ONE X Movie Archive, Inc., a
Nevada corporation; Jem Sportswear,
a California corporation; Central Mills,
Inc. (Freeze), a New York corporation;
and Leo Valencia, an individual,

Defendants and
Counterclaimants.

AND RELATED COUNTERCLAIMS.

Case No. 2:08-cv-00105-PMP-GWF

**SECOND AMENDED COMPLAINT FOR
DAMAGES AND INJUNCTIVE RELIEF**

- (1) Trademark Infringement under
15 U.S.C. § 1114 – BOB MARLEY mark
- (2) Unfair Competition under 15 U.S.C.
§ 1125(a)
- (3) Trademark Infringement under
15 U.S.C. § 1114 of TUFF GONG &
Design
- (4) Counterfeiting of TUFF GONG & Design
- (5) Trademark Infringement under
15 U.S.C. § 1114 of ROOTS ROCK
REGGAE Mark
- (6) Counterfeiting of ROOTS ROCK
REGGAE Mark
- (7) Common Law Trademark Infringement
- (8) Unauthorized Commercial Use of Right
of Publicity under NRS 597.770
- (9) Intentional Interference with Prospective
Economic Advantage

1 Plaintiffs and counter-defendants Fifty-Six Hope Road Music, Ltd ("Hope Road"),
 2 Zion Rootswear, LLC ("Rootswear"), and the Robert Marley Foundation, Ltd. ("Marley
 3 Foundation") (collectively "Plaintiffs") complain and allege as follows against Defendants.
 4 and counterclaimants A.V.E.L.A., Inc. X One X Movie Archive, Inc., Jem Sportswear,
 5 Central Mills, Inc. (Freeze), and Leo Valencia (collectively, "Defendants"):

6 NATURE OF ACTION

7 This is an action for unfair competition, trademark infringement, and counterfeiting
 8 under the Lanham Act, with pendent claims for common law trademark infringement and
 9 unauthorized commercial use of right of publicity. Plaintiffs seek damages, attorneys'
 10 fees, costs, and injunctive relief, among other things.

11 JURISDICTION

12 1. This Court has subject matter jurisdiction over this case pursuant to
 13 28 U.S.C. §§1331 and 1338(a). This Court has supplemental jurisdiction over Plaintiffs'
 14 state law claims pursuant to 28 U.S.C. § 1367(a).

15 2. This Court has personal jurisdiction over Defendant A.V.E.L.A., Inc.
 16 ("Avela") based upon the following: (a) Avela is a Nevada corporation with a principal
 17 place of business in Reno, Nevada; (b) Avela has committed tortious acts within the
 18 State of Nevada that it knew of should have known would cause injury to Plaintiffs in the
 19 State of Nevada; and (c) Avela has designed, marketed, and sold infringing merchandise
 20 to retailers who are offering such merchandise to consumers in the State of Nevada.

21 3. This Court has personal jurisdiction over Defendant X ONE X Movie
 22 Archive, Inc. ("X ONE X") based upon the following: (a) X ONE X is a Nevada
 23 corporation with a principal place of business in Reno, Nevada; (b) X ONE X has
 24 committed tortious acts within the State of Nevada that it knew of should have known
 25 would cause injury to Plaintiffs in the State of Nevada; and (c) X ONE X has designed,
 26 marketed, and sold infringing merchandise to retailers who are offering such
 27 merchandise to consumers in the State of Nevada.

28 4. This Court has personal jurisdiction over Defendant Jem Sportswear

1 ("Jem") based upon the following: (a) Jem is a California corporation with systematic
2 and continuous business related contacts within the State of Nevada; (b) Jem has
3 committed tortious acts within the State of Nevada that it knew of should have known
4 would cause injury to Plaintiffs in the State of Nevada; and (c) Jem has designed,
5 marketed, and sold infringing merchandise to retailers who are offering such
6 merchandise to consumers in the State of Nevada.

7 5. This Court has personal jurisdiction over Defendant Freeze (a division of
8 Central Mills, Inc.) ("Freeze") based upon the following: (a) Freeze is a New York
9 corporation with systematic and continuous business related contacts within the State of
10 Nevada; (b) Freeze has committed tortious acts within the State of Nevada that it knew
11 or should have known would cause injury to Plaintiffs in the State of Nevada; and (c)
12 Freeze has designed, marketed, and sold infringing merchandise to retailers who are
13 offering such merchandise to consumers in the State of Nevada.

14 6. This Court has personal jurisdiction over Defendant Leo Valencia
15 ("Valencia") based upon the following: (a) Valencia is an officer, employee, director,
16 shareholder, authorized agent, member, manager, and/or alter ego of Avela; (b)
17 Valencia has committed tortious acts within the State of Nevada that he knew of should
18 have known would cause injury to Plaintiffs in the State of Nevada; and (c) Valencia has
19 designed, marketed, and sold infringing merchandise to retailers who are offering such
20 merchandise to consumers which benefit the corporation in the State of Nevada.

21 7. Venue is proper in the United States District Court for the District of
22 Nevada under 28 U.S.C. § 1391(b) and (c). Venue lies in the unofficial Southern Division
23 of this Court.

24 PARTIES

25 8. Plaintiff Hope Road is a Bahamian corporation with a principal place of
26 business at Aquamarine House, Cable Beach, Nassau, Bahamas.

27 9. Plaintiff Rootswear is a Florida limited liability company with a principal
28 place of business at 465 Tresca Road, Jacksonville, Florida.

10. Plaintiff Marley Foundation is a Jamaican corporation with a principal place of business at 56 Hope Road, Kingston, Jamaica.

11. Upon information and belief, Defendant Avela is a Nevada corporation with a principal place of business at 1135 Terminal Way, Suite 209, Reno, NV 89502.

12. Upon information and belief, Defendant X ONE X is a Nevada corporation with a principal place of business at 1135 Terminal Way, Suite 209, Reno, NV 89502.

13. Upon information and belief, Defendant Jem is a California corporation with a principal place of business at 459 Park Avenue, San Fernando, CA 91340.

14. Upon information and belief, Defendant Freeze is a division of Central Mills, Inc., which is a New York corporation with a principal place of business at 473 Ridge Road, Dayton, NJ 08810.

15. Upon information and belief, Defendant Valencia is an individual residing in Reno, Nevada.

ALLEGATIONS COMMON TO ALL COUNTS

16. Hope Road is comprised primarily of the heirs and estate of the late, world-renowned Reggae performer Robert Nesta Marley ("Marley").

17. At all times relevant to this action, Hope Road is and has been the owner of intellectual property and publicity rights for Marley, including but not limited to:

A. Common law rights in the trademarks BOB MARLEY and MARLEY used in association with music and entertaining and merchandise which promote same.

B. U.S. Registration No. 2,349,361 for the mark BOB MARLEY for, *inter alia*, t-shirts, thermal shirts, jackets, hats, caps, sweatshirts, ties and bandanas in International Class 25. A true and correct copy of U.S. Reg. No. 2,349,361 is attached hereto as **Exhibit A**. U.S. Reg. No. 2,349,361 is incontestable, valid and subsisting.

C. U.S. Registration No. 3,456,802 for the mark ROOTS ROCK REGGAE for clothing, namely, t-shirts, hats and caps in International Class 25. A true and correct copy of U.S. Reg. No. 3,456,082 is attached hereto as **Exhibit B**.

D. Nev. Registration for Right of Publicity for Robert Nesta Marley

1 under NRS 597.800 (Reg. Vol. 1-89, Jan. 24, 2006). A true and correct copy of Hope
2 Road's registration of the rights of publicity associated with Bob Marley is attached
3 hereto as **Exhibit C**. Such registration and the rights of publicity associated therewith
4 are valid and subsisting.

5 18. At all times relevant to this action, Marley Foundation, under exclusive
6 license from Hope Road, is and has been the owner of certain intellectual property rights
7 for Marley, including U.S. Registration No. 1,866,146 for the mark TUFF GONG &
8 Design for t-shirts, hats, and sweatshirts in International Class 25, shown below:



12 A true and correct copy of U.S. Reg. No. 1,866,146 is attached hereto as **Exhibit D**.
13 U.S. Reg. No. 1,866,146 is incontestable, valid and subsisting.

14 19. At all times relevant to this action, Rootswear was Hope Road's exclusive
15 worldwide licensee for, among other things, t-shirts, jackets, hats, and other clothing and
16 merchandise bearing the above-referenced intellectual property and publicity rights for
17 Marley (the "Marley Intellectual Property" or "I.P.").

18 20. Due to the world-renowned celebrity of Marley during his life and
19 posthumously, the Marley Intellectual Property has become highly distinctive throughout
20 Las Vegas, Nevada, the United States, and internationally.

21 21. Hope Road, Marley Foundation and Rootswear have spent substantial
22 sums of money in acquiring, advertising, licensing, enforcing, and promoting the Marley
23 Intellectual Property on merchandise and in various forms of media throughout the
24 United States and internationally.

25 22. Upon information and belief, Defendants have been, and continue to be, in
26 the business or designing, manufacturing, marketing, and offering for sale in commerce,
27 clothing and other fashion related merchandise.

28 23. Upon information and belief, Defendants have been, and continue to be,

1 designing, manufacturing, marketing, and offering for sale in commerce t-shirts and other
2 fashion-related merchandise bearing the Marley Intellectual Property ("Infringing
3 Merchandise").

4 24. Defendants maintain no rights or claims to ownership of any Marley
5 Intellectual Property, and Defendants have not been granted permission or a license by
6 Hope Road, Marley Foundation or Rootswear to manufacture, distribute, or sell any
7 product bearing the Marley Intellectual Property.

8 25. The Infringing Merchandise designed, manufactured, marketed, and/or
9 sold by Defendants is substantially similar to merchandise marketed and sold by
10 Plaintiffs.

11 26. Upon information and belief, Defendants offered, bought and/or sold the
12 Infringing Merchandise to certain vendors displaying infringing merchandise at the
13 February 2007 MAGIC fashion tradeshow in Las Vegas, Nevada.

14 27. On February 14, 2007, due to Defendants' infringing actions, Hope Road
15 and Rootswear filed a complaint against Avela, Valencia, Charles Friedman ("Friedman")
16 and Fame Jeans, Inc. ("Fame") (collectively the "2007 Defendants") for trademark
17 infringement and unauthorized use of rights of publicity in U.S. Federal Court, District of
18 Nevada (Case No. 2:07-cv-194, the "2007 Action").

19 28. On February 14, 2007, in conjunction with the 2007 Action, Hope Road and
20 Rootswear filed an application for temporary restraining order and seizure order, and
21 moved for a preliminary injunction against the 2007 Defendants.

22 29. On February 15, 2007, the Court in the 2007 Action granted a temporary
23 restraining order and seizure order against the 2007 Defendants based on their
24 unauthorized marketing and sales of merchandise infringing the Marley Intellectual
25 Property.

26 30. On February 21, 2007, the parties to the 2007 Action filed a stipulation to
27 extend the temporary restraining order against the 2007 Defendants and postpone the
28 preliminary injunction hearing while the parties explored a potential settlement of the

1 2007 Action.

2 31. In August of 2007, Hope Road and Rootswear entered into a settlement
3 agreement with Friedman and Fame resolving all claims against Friedman and Fame in
4 the 2007 Action.

5 32. Hope Road and Rootswear were unable to reach a successful settlement
6 of the 2007 Action with Avela and Valencia.

7 33. On November 29, 2007, the 2007 Action was dismissed without prejudice.

8 34. On or about December 20, 2007, representatives from Hope Road and
9 Rootswear discovered t-shirts similar to the infringing merchandise at issue in the 2007
10 Action being sold at Target retail stores bearing the Marley Intellectual Property.

11 35. Upon information and belief, Defendants have been, and continue to be,
12 designing, manufacturing, distributing, buying and/or selling the Infringing Merchandise
13 to Target and other national retailers.

14 36. Defendants' actions in manufacturing, distributing, buying and/or selling the
15 Infringing Merchandise have caused, and continues to cause, confusion among
16 consumers who are led to believe that the Infringing Merchandise is authentic and
17 licensed Marley merchandise, when in fact it is not.

18 37. Based on, among other things, the allegations in the 2007 Action, the
19 terms of the corresponding temporary restraining order, and the various demands from
20 Hope Road and Rootswear, Defendants are fully aware that they lack the authority or
21 license to design, manufacture, distribute, sell, exhibit, or market the Infringing
22 Merchandise.

23 38. By designing, manufacturing, distributing, buying and/or selling the
24 Infringing Merchandise, Defendants were and are attempting to trade on the goodwill
25 established by Plaintiffs in the Marley Intellectual Property.

26 39. By designing, manufacturing, distributing, buying and/or selling the
27 Infringing Merchandise, Defendants were and are attempting to create an association
28 between the Infringing Merchandise and the authorized Marley merchandise sold and

1 licensed by Plaintiffs.

2 40. Upon information and belief, Defendants manufactured, distributed, bought
3 and/or sold the Infringing Merchandise with the bad faith intent to profit from the name
4 and likeness of Robert Nesta Marley and the associated and registered Rights of
5 Publicity owned by Hope Road.

6 41. Upon information and belief, Defendants' continued design, manufacture,
7 buying, sale, distribution, exhibition, and/or marketing of the Infringing Merchandise
8 constitutes federal and common law trademark infringement, unfair competition,
9 unauthorized use of rights of publicity, and intentional interference with prospective
10 economic advantage.

11 42. Upon information and belief, Defendants did not believe or have
12 reasonable grounds to believe that the design, marketing, distribution, buying, or sale of
13 the Infringing Merchandise was a fair use or otherwise lawful.

14 **FIRST CLAIM FOR RELIEF**
15 **(Trademark Infringement under**
the Lanham Act, 15 U.S.C. § 1114)

16 43. Plaintiffs incorporate the allegations in the preceding paragraphs as if fully
17 set forth herein.

18 44. Defendants have used and/or are using in commerce merchandise bearing
19 the Marley Intellectual Property, and, thus is confusingly similar to the BOB MARLEY
20 federally registered trademark (the "BOB MARLEY Mark").

21 45. Defendants' use in commerce of the BOB MARLEY Mark, constitutes a
22 reproduction, copying, counterfeiting, and colorable imitation of Plaintiffs' trademark in a
23 manner that is likely to cause confusion or mistake or is likely to deceive consumers.

24 46. By using Plaintiffs' BOB MARLEY Mark or a mark confusingly similar
25 thereto with the knowledge that Plaintiffs own or have exclusive and enforceable
26 licenses to use the BOB MARLEY Mark in Las Vegas, across the United States, and
27 around the world, Defendants have intended to cause confusion, cause mistake, or
28 deceive consumers.

1 47. Defendants are using a mark identical, or at the least similar, to Plaintiffs'
2 BOB MARLEY Mark in connection with the manufacture, distribution, purchase and sale
3 of products in a manner that is likely to cause confusion, or to cause mistake, or to
4 deceive consumers as to affiliation, connection, or association with Plaintiffs or Bob
5 Marley, or as to the origin, sponsorship, or approval of Defendants' products and
6 commercial activities by Plaintiffs.

7 48. Defendants' use of the BOB MARLEY Mark or a mark confusingly similar
8 thereto has created a likelihood of confusion among consumers who may falsely believe
9 that Defendants' products are associated with Plaintiffs' genuine merchandise bearing
10 the Marley Intellectual Property or that Plaintiffs sponsor or approve of Defendants'
11 products or commercial activities.

12 49. Defendants' actions constitute infringement of the BOB MARLEY Mark in
13 violation of 15 U.S.C. § 1114.

14 50. As a direct and proximate result of Defendants' infringement, Plaintiffs
15 have suffered, and will continue to suffer, monetary loss and irreparable injury to their
16 business, reputation, and goodwill.

17 **SECOND CLAIM FOR RELIEF**
18 **(Unfair Competition/False Designation of Origin under the**
19 **Lanham Act, 15 U.S.C. § 1125(a))**

20 51. Plaintiffs incorporate the allegations in the preceding paragraphs as if fully
21 set forth herein.

22 52. Defendants' unauthorized use in commerce of the Marley Intellectual
23 Property in connection with Defendants' clothing and fashion related merchandise
24 constitutes a false designation of origin, a false or misleading description or
25 representation of fact, and/or a false endorsement, which is likely to cause confusion,
26 cause mistake, or deceive as to affiliation, connection, or association with Plaintiffs or
27 Bob Marley, or as to the origin, sponsorship, or approval of Defendants' products or
28 commercial activities by Plaintiffs.

53. Defendants' use in commerce of the Marley Intellectual Property with the

1 knowledge that Plaintiffs own the exclusive right to the commercial use of the Marley
2 Intellectual Property, constitutes intentional conduct by Defendants to make false
3 designations of origin, false descriptions about Defendants' products and commercial
4 activities, and false endorsement of Defendants' products.

5 54. Defendants' actions constitute false designation of origin and unfair
6 competition under 15 U.S.C. § 1125(a).

7 55. As a direct and proximate result of such unfair competition, Plaintiffs have
8 suffered, and will continue to suffer, monetary loss and irreparable injury to their
9 business, reputation, and goodwill.

10 **THIRD CLAIM FOR RELIEF**
11 **(Trademark Infringement**
under the Lanham Act, 15 U.S.C. § 1114)

12 56. Plaintiffs incorporate the allegations in the preceding paragraphs as if fully
13 set forth herein.

14 57. Defendants have used and/or are using in commerce merchandise bearing
15 the Marley Intellectual Property, specifically images of Bob Marley, and thus is
16 confusingly similar to the TUFF GONG & Design federally registered trademark, which
17 includes the image of Bob Marley (the "TUFF GONG Mark").

18 58. Defendants' use in commerce of images of Bob Marley on products
19 constitutes a reproduction, copying, and colorable imitation of the TUFF GONG Mark in
20 a manner that is likely to cause confusion or mistake or is likely to deceive consumers.

21 59. Defendants have intended to cause confusion, cause mistake, or deceive
22 consumers by their use of Bob Marley's image, among other things, on products.

23 60. Defendants' use of Bob Marley's image in connection with the
24 manufacture, distribution, purchase and sale of products is in a manner that is likely to
25 cause confusion, or to cause mistake, or to deceive consumers as to affiliation,
26 connection, or association with Plaintiffs or Bob Marley or as to the origin, sponsorship,
27 or approval of Defendants' products and commercial activities by Plaintiffs.

28 61. Defendants' use of Bob Marley's image constitutes infringement of the

1 TUFF GONG Mark in violation of 15 U.S.C. § 1114.

2 62. As a direct and proximate result of Defendants' infringement, Plaintiffs
3 have suffered, and will continue to suffer, monetary loss and irreparable injury to their
4 business, reputation, and goodwill.

5 **FOURTH CLAIM FOR RELIEF**
6 **(Counterfeiting Under**
7 **15 U.S.C. § 1114, § 1116(d), and § 1117)**

8 63. Plaintiffs incorporate the allegations in the preceding paragraphs as if fully
9 set forth herein.

10 64. Defendants have used and/or are using in commerce merchandise bearing
11 the Marley Intellectual Property, specifically images of Bob Marley, and thus is
12 confusingly similar to the TUFF GONG Mark, which is a federally registered trademark
13 and includes the image of Bob Marley.

14 65. Defendants' use in commerce of images of Bob Marley on products
15 constitutes a reproduction, copying, and colorable imitation of the TUFF GONG Mark in
16 a manner that is likely to cause confusion or mistake or is likely to deceive consumers.

17 66. Defendants have intended to cause confusion, cause mistake, or deceive
18 consumers and to profit from the unauthorized use of the image of Bob Marley among
19 other things, on merchandise.

20 67. Defendants are using images of Bob Marley that are substantially
21 indistinguishable from the TUFF GONG Mark in connection with the manufacture,
22 distribution, purchase and sale of products in a manner that is likely to cause confusion,
23 or to cause mistake, or to deceive consumers as to affiliation, connection, or association
24 with Plaintiffs or Bob Marley or as to the origin, sponsorship, or approval of Defendants'
25 products and commercial activities by Plaintiffs.

26 68. Defendants' actions constitute counterfeiting under 15 U.S.C. §1114,
27 1116(d), and 1117(b) and (c).

28 69. As a direct and proximate result of Defendants' counterfeiting, Plaintiffs
have suffered, and will continue to suffer, monetary loss and irreparable injury to their

1 business, reputation, and goodwill.

2 **FIFTH CLAIM FOR RELIEF**
3 **(Trademark Infringement under**
4 **the Lanham Act, 15 U.S.C. § 1114)**

5 70. Plaintiffs incorporate the allegations in the preceding paragraphs as if fully
6 set forth herein.

7 71. Defendants have used and/or are using in commerce merchandise bearing
8 the Marley Intellectual Property, and thus is confusingly similar to the ROOTS ROCK
9 REGGAE federally registered trademark (the "ROOTS ROCK REGGAE Mark").

10 72. Defendants' use in commerce of the ROOTS ROCK REGGAE Mark,
11 constitutes a reproduction, copying, counterfeiting, and colorable imitation of Plaintiffs'
12 trademark in a manner that is likely to cause confusion or mistake or is likely to deceive
13 consumers.

14 73. By using Plaintiffs' ROOTS ROCK REGGAE Mark or a mark confusingly
15 similar thereto with the knowledge that Plaintiffs own or have exclusive and enforceable
16 licenses to use the ROOTS ROCK REGGAE Mark in Las Vegas, across the United
17 States, and around the world, Defendants have intended to cause confusion, cause
18 mistake, or deceive consumers.

19 74. Defendants are using a mark identical, or at the least similar, to Plaintiffs'
20 ROOTS ROCK REGGAE Mark in connection with the manufacture, distribution,
21 purchase and sale of products in a manner that is likely to cause confusion, or to cause
22 mistake, or to deceive consumers as to affiliation, connection, or association with
23 Plaintiffs or Bob Marley, or as to the origin, sponsorship, or approval of Defendants'
24 products and commercial activities by Plaintiffs.

25 75. Defendants' use of the ROOTS ROCK REGGAE Mark or a mark
26 confusingly similar thereto has created a likelihood of confusion among consumers who
27 may falsely believe that Defendants' products are associated with Plaintiffs' genuine
28 merchandise bearing the Marley Intellectual Property or that Plaintiffs sponsor or
approve of Defendants' products or commercial activities.

76. Defendants' actions constitute infringement of the BOB MARLEY Mark in violation of 15 U.S.C. § 1114.

77. As a direct and proximate result of Defendants' infringement, Plaintiffs have suffered, and will continue to suffer, monetary loss and irreparable injury to their business, reputation, and goodwill.

SIXTH CLAIM FOR RELIEF
(Counterfeiting Under
15 U.S.C. § 1114, § 1116(d), and § 1117

78. Plaintiffs incorporate the allegations in the preceding paragraphs as if fully set forth herein.

79. Defendants have used and/or are using in commerce merchandise bearing the Marley Intellectual Property, specifically the ROOTS ROCK REGGAE Mark or marks confusingly similar thereto, and thus is confusingly similar to the ROOTS ROCK REGGAE Mark, which is a federally registered trademark.

80. Defendants' use in commerce of images of Bob Marley on products constitutes a reproduction, copying, and colorable imitation of the ROOTS ROCK REGGAE Mark in a manner that is likely to cause confusion or mistake or is likely to deceive consumers.

81. Defendants have intended to cause confusion, cause mistake, or deceive consumers and to profit from the unauthorized use of the image of Bob Marley among other things, on merchandise.

82. Defendants are using images of Bob Marley that are substantially indistinguishable from the ROOTS ROCK REGGAE Mark in connection with the manufacture, distribution, purchase and sale of products in a manner that is likely to cause confusion, or to cause mistake, or to deceive consumers as to affiliation, connection, or association with Plaintiffs or Bob Marley or as to the origin, sponsorship, or approval of Defendants' products and commercial activities by Plaintiffs.

83. Defendants' actions constitute counterfeiting under 15 U.S.C. §1114, 1116(d), and 1117(b) and (c).

1 84. As a direct and proximate result of Defendants' counterfeiting, Plaintiffs
2 have suffered, and will continue to suffer, monetary loss and irreparable injury to their
3 business, reputation, and goodwill.

4
5 **SEVENTH CLAIM FOR RELIEF**
6 **(Common Law Trademark Infringement)**

7 85. Plaintiffs incorporate the allegations in the preceding paragraphs as if fully
8 set forth herein.

9 86. By virtue of having used and continuing to use the BOB MARLEY Mark
10 and the image of Bob Marley, Plaintiffs have acquired common law rights in those
11 marks.

12 87. Defendants' use of the BOB MARLEY Mark, MARLEY, and images of Bob
13 Marley infringes Plaintiffs' common law rights in the BOB MARLEY and MARLEY
14 trademarks and the TUFF GONG Mark and image of Bob Marley therein, and this use is
15 likely to cause confusion, mistake, or deception among consumers, who will believe that
16 Defendants' products, clothing, and fashion related merchandise are affiliated or
17 connected with, or endorsed, licensed, or sponsored by Plaintiffs or Bob Marley when, in
18 fact, they are not.

19 88. As a direct and proximate result of Defendants' infringement of Plaintiffs'
20 common law trademark rights under Nevada and other common law, Plaintiffs have
21 suffered, and will continue to suffer, monetary damages and irreparable injury to their
22 business, reputation, and goodwill.

23 **EIGHTH CLAIM FOR RELIEF**
24 **(Unauthorized Commercial Use of Right of Publicity**
25 **under N.R.S. § 597.770 et seq.)**

26 89. Plaintiffs incorporate the allegations in the preceding paragraphs as if fully
27 set forth herein.

28 90. Throughout his life, Marley, as a world-renowned reggae musician and
performer, acquired valuable goodwill and commercial value in his persona including but
not limited to his name, voice, signature, photograph, and likeness in Nevada,

1 throughout the United States, and internationally.

2 91. Under Nevada law, the goodwill and commercial value in Marley's name,
3 voice, signature, photograph, likeness, and his Rights of Publicity creates an absolute,
4 incorporeal, and transferable property right in such goodwill and commercial value.

5 92. On January 24, 2006, as successor-in-interest to the Marley Intellectual
6 Property and as heirs to the estate of Robert Nesta Marley, Hope Road registered its
7 claim to the rights of publicity in Robert Nesta Marley (the "Marley Rights of Publicity")
8 with the Nevada Secretary of State pursuant to NRS 597.800. Hope Road has also
9 registered the rights of publicity in other states.

10 93. Defendants have used in commerce, and continue to use in commerce, the
11 name, voice, signature, photograph, and/or likeness of Marley on merchandise, in
12 media, and on marketing materials, without the consent of Hope Road.

13 94. As a direct and proximate result of Defendants' infringement of the Marley
14 Rights of Publicity under NRS 597.800, Plaintiffs have suffered, and will continue to
15 suffer, monetary damages and irreparable injury to their business, reputation, and
16 goodwill.

17 95. Upon information and belief, Defendants were fully aware that Hope Road,
18 as the successor-in-interest to the Marley Rights of Publicity, was the only entity that
19 could consent to the commercial use of Marley's name, voice, signature, photograph,
20 and/or likeness, and that Defendants had not obtained such consent from Hope Road.

21 96. Due to Defendants' knowing infringement of the Marley Rights of Publicity,
22 Plaintiffs are entitled to an award of exemplary and/or punitive damages.

23 **NINTH CLAIM FOR RELIEF**
24 **(Intentional Interference with**
Prospective Economic Advantage)

25 97. Plaintiffs incorporate the allegations in the preceding paragraphs as if fully
26 set forth herein.

27 98. Upon information and belief, at the time Defendants adopted and began
28 using the Marley Intellectual Property and since that time, Defendants knew and have

1 known that Plaintiffs are the sole entities with the right and authority to use the Marley
2 Intellectual Property in commerce.

3 99. Upon information and belief, Defendants committed acts intended or
4 designed to disrupt Plaintiffs' prospective economic advantage arising from advertising
5 and/or providing products bearing the Marley Intellectual Property.

6 100. Defendants' actions have disrupted or are intended to disrupt Plaintiffs'
7 business by, among other things, diverting customers away from genuine authorized
8 products bearing the Marley Intellectual Property to Defendants' unauthorized products
9 bearing the same.

10 101. Defendants have no legal right, privilege or justification for their conduct.

11 102. As a direct and proximate result of Defendants' intentional interference with
12 Plaintiffs' prospective economic advantage, Plaintiffs have suffered, and will continue to
13 suffer, monetary damages and irreparable injury.

14 103. Based on the intentional, willful and malicious nature of Defendants'
15 actions, Plaintiffs are entitled to recover exemplary damages and reasonable attorneys'
16 fees and costs incurred in connection with this action.

17 **PRAYER FOR RELIEF**

18 WHEREFORE, Plaintiffs respectfully pray that the Court grant the following relief:

19 A. Finding that Defendants have infringed the BOB MARLEY Mark
20 under 15 U.S.C. § 1114; infringed the BOB MARLEY and MARLEY trademarks under
21 the common law; infringed the TUFF GONG Mark under 15 U.S.C. § 1114 and under the
22 common law; have counterfeited the TUFF GONG Mark under 15 U.S.C. § 1114, 1116,
23 and 1117; have infringed the ROOTS ROCK REGGAE Mark under 15 U.S.C. § 1114
24 and under the common law; have counterfeited the ROOTS ROCK REGGAE Mark
25 under 15 U.S.C. §§ 1114, 1116(d) and 1117; have violated 15 U.S.C. § 1125(a); have
26 violated the rights of publicity associated with Bob Marley; and have intentionally
27 interfered with prospective business advantage of Plaintiffs;

28 B. Ordering a preliminary and permanent injunction, on a worldwide

1 basis, prohibiting Defendants, their respective officers, agents, servants, employees,
2 licensees, related companies, assigns, attorneys, and/or all persons acting in concert or
3 participation with them, from: (1) using the BOB MARLEY Mark, the MARLEY Mark, the
4 TUFF GONG Mark, or the ROOTS ROCK REGGAE Mark alone or in combination with
5 any other letters, words, letter strings, phrases, images, or designs, in commerce or in
6 connection with any business or for any other purpose (including, but not limited to,
7 clothing and fashion related merchandise) or any mark, name, symbol, logo, or other
8 indicia likely to be confused with the BOB MARLEY Mark, the MARLEY Mark, the TUFF
9 GONG Mark, or the ROOTS ROCK REGGAE Mark or likely to cause mistake, or to
10 deceive as to the affiliation, connection, or association of Defendants with Plaintiffs or
11 any of them, or as to the origin, sponsorship, or approval of their goods, services, or
12 commercial activities; (2) using Marley's name, voice, signature, photograph, or likeness
13 in commerce or in connection with any business or for any other purpose (including, but
14 not limited to, clothing and fashion related merchandise); (3) using Bob Marley's image
15 or any other image that is a counterfeit, copy, colorable imitation or, incorporates or is
16 substantially indistinguishable from the TUFF GONG Mark; and (4) knowingly assisting,
17 inducing, aiding or abetting any other person or business in engaging in or performing
18 any of the activities referred to in Paragraph B(1)-(3);

19 C. Ordering a preliminary and permanent injunction, on a worldwide
20 basis, requiring any known and current retailers of the Infringing Merchandise to transfer
21 any and all such merchandise to Plaintiffs;

22 D. Ordering that Hope Road is the exclusive owner of the Marley
23 Intellectual Property and that said intellectual property is valid;

24 E. Ordering an award of compensatory, consequential, statutory, and
25 punitive damages to Plaintiffs in an amount to be determined at trial;

26 F. Ordering that Defendants account to Plaintiffs for any and all profits
27 earned or received as a result of Defendants' aforesaid acts of infringement,
28 counterfeiting, false designation of origin and unfair competition, violation of right of

1 publicity, and intentional interference with prospective economic advantage;

2 G. Ordering an award of interest, costs and attorneys' fees incurred by
3 Plaintiffs in prosecuting this action;

4 H. Ordering pre-judgment interest; and

5 I. All other relief to which Plaintiffs are entitled.

6 MANATT, PHELPS & PHILLIPS LLP

7 Dated: July 22, 2009

8 By: /s/ Jill M. Pietrini

Jill M. Pietrini

9 *Attorneys for Plaintiffs and Counter-*
Defendants

10 FIFTY-SIX HOPE ROAD MUSIC, LTD. &
11 ZION ROOTSWEAR, LLC

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EXHIBIT A

Int. Cls.: 3, 6, 9, 14, 16, 18, 21, 24, 25, 26 and 34

Prior U.S. Cls.: 1, 2, 3, 4, 5, 6, 8, 9, 12, 13, 14, 17,
21, 22, 23, 25, 26, 27, 28, 29, 30, 33, 36, 37, 38, 39,
40, 41, 42, 50, 51 and 52

Reg. No. 2,349,361

United States Patent and Trademark Office

Registered May 16, 2000

**TRADEMARK
PRINCIPAL REGISTER**

BOB MARLEY

FIFTY-SIX HOPE ROAD MUSIC LIMITED (BA-
HAMAS INTERNATIONAL BUSINESS COM-
PANY)

AQUAMARINE HOUSE
CABLE BEACH
NASSAU, BAHAMAS

FOR: INCENSE, IN CLASS 3 (U.S. CLS. 1, 4, 6,
50, 51 AND 52).

FIRST USE 0-0-1996; IN COMMERCE
0-0-1996.

FOR: NOVELTY LICENSE PLATE OF NON-
PRECIOUS METAL, IN CLASS 6 (U.S. CLS. 2,
12, 13, 14, 23, 25 AND 50).

FIRST USE 0-0-1995; IN COMMERCE
0-0-1995.

FOR: PLASTIC CASES FOR BEEPERS; MAG-
NETS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND
38).

FIRST USE 0-0-1996; IN COMMERCE
0-0-1996.

FOR: JEWELRY; WATCHES; MEDALLIONS,
IN CLASS 14 (U.S. CLS. 2, 27, 28 AND 50).

FIRST USE 0-0-1994; IN COMMERCE
0-0-1994.

FOR: GREETING CARDS; STICKERS; STA-
TIONERY TYPE PORTFOLIOS; POSTERS;
POSTCARDS; POSTCARD BOOKS; SONG-
BOOKS; DECALS; TRADING CARDS; CALEN-
DARS; NOVELS; BOOKMARKS, IN CLASS 16
(U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 0-0-1990; IN COMMERCE
0-0-1990.

FOR: BACKPACKS; FANNY PACKS; WAL-
LETS; TOTE BAGS, IN CLASS 18 (U.S. CLS. 1, 2,
3, 22 AND 41).

FIRST USE 0-0-1992; IN COMMERCE
0-0-1992.

FOR: MUGS, IN CLASS 21 (U.S. CLS. 2, 13, 23,
29, 30, 33, 40 AND 50).

FIRST USE 0-0-1995; IN COMMERCE
0-0-1995.

FOR: TEXTILE WALL HANGINGS, IN
CLASS 24 (U.S. CLS. 42 AND 50).

FIRST USE 0-0-1990; IN COMMERCE
0-0-1990.

FOR: T-SHIRTS; THERMAL SHIRTS; JACK-
ETS; HATS; CAPS; SWEATSHIRTS; TIES; BAN-
DANNAS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 0-0-1990; IN COMMERCE
0-0-1990.

FOR: ORNAMENTAL CLOTH PATCHES, IN
CLASS 26 (U.S. CLS. 37, 39, 40, 42 AND 50).

FIRST USE 0-0-1990; IN COMMERCE
0-0-1990.

FOR: SMOKING PIPES, IN CLASS 34 (U.S.
CLS. 2, 8, 9 AND 17).

FIRST USE 0-0-1996; IN COMMERCE
0-0-1996.

BOB MARLEY IS THE NAME OF AN INDI-
VIDUAL WHO IS NOW DECEASED.

SER. NO. 75-489,475, FILED 5-21-1998.

SHANNA BLAUSTEIN, EXAMINING ATTOR-
NEY

EXHIBIT B

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 3,456,082

Registered July 1, 2008

**TRADEMARK
PRINCIPAL REGISTER**

ROOTS ROCK REGGAE

FIFTY-SIX HOPE ROAD MUSIC LIMITED (BA-
HAMAS INTERNATIONAL BUSINESS COM-
PANY)

AQUAMARINE HOUSE CABLE BEACH
NASSAU, BAHAMAS

FIRST USE 7-1-2004; IN COMMERCE 7-1-2004.

SER. NO. 76-665,673, FILED 9-5-2006.

FOR: CLOTHING, NAMELY, T-SHIRTS, HATS
AND CAPS, IN CLASS 25 (U.S. CLS. 22 AND 39).

RONALD AIKENS, EXAMINING ATTORNEY

EXHIBIT C



DEAN HELLER
Secretary of State
555 E. Washington Ave., #4000
Las Vegas, Nevada 89101
(702) 486 2880
Website: secretaryofstate.biz

FILED # Vol 1-89

JAN 24 2006

IN THE OFFICE OF
Dean Heller
DEAN HELLER, SECRETARY OF STATE

**Application For Registration Of
Claim To Right Of Publicity
(PURSUANT TO NRS 597.800)**

Cedella Marley on behalf of
Fifty Six Hope Road Music, Ltd. Op/o Bob Marley Music, Inc, 632 Broadway
Suite 901, New York, NY 10012
BEING FIRST DULY SWORN, UNDER PENALTY OF PERJURY,
the corporation
DEPOSES AND SAYS THAT HE IS THE: (check one box only) ☒ SUCCESSOR IN INTEREST ☐ LICENSEE
OF Robert Nesta Marley

Legal Name of Deceased Person

Bob Marley

Professional Name of Deceased Person

WHO DIED ON May 11, 1981

Date of Death of Deceased Person

THAT THE BASIS OF THE CLAIMANT'S CLAIM IS
IS AS FOLLOWS: Hope Road is comprised of the surviving children of Bob Marley,
the rightful heirs, to his Publicity rights.

THAT THE FOLLOWING IS A DESCRIPTION OF THE RIGHTS CLAIMED: All rights in and to the name,
Image, likeness, trademark and other indicia, and other identifiable aspects of
Bob Marley.

DATED THIS 12 DAY OF January, 2006.

BY CLAIMANT:

Cedella Marley on behalf of Fifty Six Hope Road Music, Ltd.

STATE OF New York, COUNTY OF New York. THIS INSTRUMENT WAS
ACKNOWLEDGED BEFORE ME ON 01/12/2006.

Veronica E. Evert
Notary Signature

Veronica E. Evert
Notary Public State of New York
No. 01EV6106323
Qualified in Nassau County
Commission Expires March 1, 2008

Notary Stamp

Notary of State Form RIGHT OF PUBLICITY 200
Revised 01/02/05

EXHIBIT D

Int. Cls.: 9, 16, and 25

Prior U.S. Cls.: 21, 36, 38, and 39

United States Patent and Trademark Office **Reg. No. 1,866,146**
Registered Dec. 6, 1994

**TRADEMARK
PRINCIPAL REGISTER**



TUFF GONG INTERNATIONAL LIMITED (JAMAICA CORPORATION)
220 MARCUS GARVEY DRIVE
KINGSTON 11, JAMAICA

FOR: MUSICAL SOUND RECORDINGS, IN CLASS 9 (U.S. CLS. 21 AND 36).

FIRST USE 0-0-1979; IN COMMERCE 0-0-1979.

FOR: POSTERS, UNMOUNTED PHOTOGRAPHS AND PHOTOGRAPHIC PRINTS, IN CLASS 16 (U.S. CL. 38).

FIRST USE 0-0-1978; IN COMMERCE 0-0-1978.

FOR: T-SHIRTS, HATS, SWEATSHIRTS, IN CLASS 25 (U.S. CL. 39).

FIRST USE 0-0-1978; IN COMMERCE 0-0-1978.

THE MARK COMPRISES IN PART THE REPRESENTATION OF BOB MARLEY, WHO IS DECEASED.

SN 74-801,867, FILED 1-22-1993.

MICHAEL A. SZOKE, EXAMINING ATTORNEY